

OPPEDAHL & LARSON LLP
DILLON, COLORADOCARL OPPEDAHL
MARINA T. LARSON, PH.D.
RYAN E. ANDERSONTEL: + 1 970 468-6600
FAX: + 1 970 468-0104
WWW.PATENTS.COM

October 29, 2004

RECEIVED

3 NOV 2004

By Facsimile Only: 703-305-8664
(12 pages total)Director Jon Dudas
United States Patent and Trademark Office
P O Box 1450
Alexandria, VA 22313-1450Legal Staff
International DivisionRe: U.S. Patent Application Number 09/857,136; now U.S. Patent Number 6,678,242
For: *Signaling System for Telecommunications*
Our File No.: TLSIP-001

Dear Director Dudas:

On May 21, 2001, an International Preliminary Examination Report for PCT/US99/26894 was issued. This is the PCT application from which the above-referenced U.S. National Phase application was filed. In the IPER, claims 1-8 were proven to have Novelty, Inventive Step, and Industrial Applicability. Claims 9-15 did not meet all three of these criteria.

On June 1, 2001, form PTO-1390 was filed, with a Preliminary Amendment, entering the U.S. National Phase from this PCT application. In the Preliminary Amendment, Claims 9-15 were canceled.

On October 15, 2001, our USPTO Deposit Account was charged \$295.00 for extra claims -- the claims that were canceled in the Preliminary Amendment.

On April 11, 2002 we filed a Request for Refund of this overcharged amount.

On May 14, 2002, an acknowledgment of receipt of our Request for Refund was mailed by the Refund Section of the Office of Finance.

On March 17, 2003, Rita White of the Refund Section of the Office of Finance mailed a letter denying our Refund Request saying "The IPER does not indicate that the claims meet the criteria for the smaller fee."

POSTAL ADDRESS: P.O. BOX 5088, DILLON, COLORADO 80435-5088
VISITING ADDRESS: 256 DILLON RIDGE RD, DILLON, CO 80435-5088

On August 21, 2003, we mailed Ms. White a letter enclosing a copy of the IPER and the Preliminary Amendment, reiterating the fact that claims 1-8 meet the criteria for the smaller fee.

To date, we have received no response.

Enclosed for your convenient reference are copies of all the above-referenced documents. Please direct a refund of \$295.00 to our Deposit Account Number 15-0610, as requested in our previously filed papers. Thank you.

Very truly yours,

A handwritten signature in black ink, appearing to read "Carl Oppedahl", written in a cursive style.

Carl Oppedahl

CO/mmww

Enclosures

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To: CARL OPPEDAHL
OPPEDAHL & LARSON LLP
256 DILLON RIDGE ROAD
P.O. BOX 5068
DILLON CO 80435

PCT

NOTIFICATION OF TRANSMITTAL OF
INTERNATIONAL PRELIMINARY
EXAMINATION REPORT

(PCT Rule 71.1)

Date of Mailing
(day/month/year)

21 MAY 2001

Applicant's or agent's file reference

TLSIP00WO

IMPORTANT NOTIFICATION

International application No.

PCT/US99/26894

International filing date (day/month/year)

12 NOVEMBER 1999

Priority Date (day/month/year)

01 DECEMBER 1998

Applicant

SIMON, THOR

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

REPORTING LETTER
COMPUTER DOCKET
PAPER DOCKET

C

MAY 24 2001

ps

Name and mailing address of the IPEA/US

Commissioner of Patents and Trademarks
Box PCT
Washington, D.C. 20231

Facsimile No. (703) 305-3230

Authorized officer

SOON-DONG HYUN

Telephone No. (703) 308-0900

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference TLSIP00WO	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US99/26894	International filing date (day/month/year) 12 NOVEMBER 1999	Priority date (day/month/year) 01 DECEMBER 1998
International Patent Classification (IPC) or national classification and IPC IPC(7): H04L 12/56; H04M 7/06 and US Cl.: 370/389, 466, 379/230		
Applicant SIMON, THOR		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 4 sheets.

☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority. (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 0 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of report with regard to novelty, inventive step or industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 05 JULY 2000	Date of completion of this report 29 MARCH 2001
Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703) 305-3230	Authorized officer SOON-DONG HYUN <i>Kyugema Zogan</i> Telephone No. (703) 308-0000

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US99/26894

I. Basis of the report

1. With regard to the elements of the international application:*

- ☒ the international application as originally filed
- ☒ the description:
pages 1-25, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of
- ☒ the claims:
pages 26-32, as originally filed
pages NONE, as amended (together with any statement) under Article 19
pages NONE, filed with the demand
pages NONE, filed with the letter of
- ☒ the drawings:
pages 1-4, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of
- ☒ the sequence listing part of the description:
pages NONE, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in printed form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☒ The amendments have resulted in the cancellation of:

- ☒ the description, pages NONE
- ☒ the claims, Nos. NONE
- ☒ the drawings, sheets/fig NONE

5. ☐ This report has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

**Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US99/26894

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. statement**

Novelty (N)	Claims <u>1-8 and 12</u>	YES
	Claims <u>9-11 and 13-15</u>	NO
Inventive Step (IS)	Claims <u>1-8</u>	YES
	Claims <u>9-15</u>	NO
Industrial Applicability (IA)	Claims <u>1-15</u>	YES
	Claims <u>NONE</u>	NO

2. citations and explanations (Rule 70.7)

Claims 9-11, and 13-15, lack novelty under PCT Article 33(2) as being anticipated by Moquin et al (U.S. Patent No. 5,519,768).

Regarding claim 9, 13, and 14, Moquin et al discloses an advanced intelligent network (AIN) 10 to communicate common channel signaling data for a telephone processing. The AIN is a packet switching network employing a SS7 protocol and connects a plurality of service switching points (SSPs) 12, 14 (a first and a second apparatus, respectively), a signal transfer point (STP) and a service control point (SCP). Each SSP receives common channel signaling data from connected subscribers and encapsulates the data into packets to transmit the packets via the AIN. Each SSP also receives packets from the AIN and extracts the common channel signaling data from the packets and transmits the data to the subscribers. See col. 5, line 53-col. 6, line 45.

the AIN is a wide area network. A routing table is inherently required in the each SSP, because the SSP is a node of the packet switched network. The routing table in each node is used for routing packets and periodically updated.

Regarding claims 10 and 15, a packet assembling process and a packet de-assembling process in accordance with a protocol for transmitting and receiving to/from the AIN are equivalent to encrypting (encapsulating) and decrypting (unencapsulating) in the claims.

Regarding claim 11, the SSP is synchronously receiving and transmitting the common channel signaling data from/to the subscribers.

Claim 12 lack an inventive step under PCT Article 33(3) as being obvious over Moquin et al in view of Blumhardt et al (U.S. Patent No. 5,629,978).

Moquin et al teaches the AIN is based on SS7 protocol. Blumhardt et al (Blumhardt) teaches a signaling network using TCP/IP protocol. See Fig. 1. Therefore, to use TCP/IP protocol for the AIN instead of SS7 protocol to transmit the data via Internet would not have an inventive step.

Claims 1-8 meet the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest a packet-
(Continued on Supplemental Sheet.)

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US99/26894

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

V. 2. REASONED STATEMENTS - CITATIONS AND EXPLANATIONS (Continued):

because the prior art does not teach or fairly suggest a packet-switch communication channel of a type routing messages over an arbitrary path comprising hops including a final hop in which the final hop of the path is not fully known in advance as recited in the claims 1 and 7.

Claims 1-15 meet the criteria set out in PCT Article (4), because a common channel signaling has use in a telecommunication network.

----- NEW CITATIONS -----

US 5,519,768 A (MOQUIN et al) 21 MAY 1996, see col. 5, line 53-col. 6; line 45.

US 5,629,978 A (BLUMHARDT et al) 13 MAY 1997, see FIG. 1.

ATTORNEY DOCKET NO. TLSI.P-001
PATENT APPLICATION
June 1, 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Simon
Serial No. : TBA
Filing Date : Herewith
Title : Improved Signaling System for Telecommunications

PRELIMINARY AMENDMENT

Assistant Commissioner for Patents
Box PCT
US Patent and Trademark Office
Washington, D.C. 20231

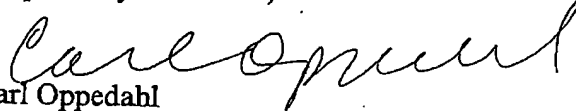
Sir:

Preliminary to the calculation of claim fees and examination of the application filed herewith, please make the following amendments:

In the claims:

Please cancel claims 9 - 15.

Respectfully submitted,


Carl Oppedahl
Oppedahl & Larson LLP
Reg. No. 32,746
P.O. Box 5068
Dillon, CO 80345-5068
970-468-6600

I hereby certify that this paper and the attachments named herein are being deposited with the United States Postal Service as Express Mail #EL556130985US in an envelope addressed to Assistant Commissioner of Patents, Box PCT, US. Patent and Trademark Office, Washington, D.C. 20231 on June 1, 2001.

6/1/01
Date of Signature


Linda L. Orr

TL51 Pool



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

May 14, 2002

OPPEDAHL AND LARSON LLP
P O BOX 5068
DILLON, CO 80435-5068
US

Dear Sir/Madam,

This is to Acknowledge receipt of your refund request in the amount of \$295.00 for patent/serial number 09857136.

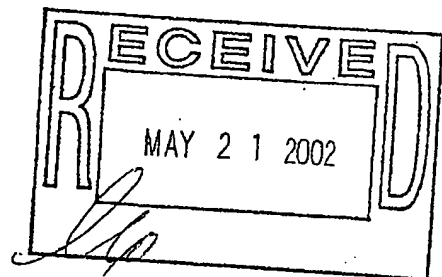
Your request has been forwarded to RITA WHITE for review and processing.

To inquire about the status of your refund request, please call 703 305-6668/3620.

Thank you,

Refund Section, Office of Finance

31-37



Attorney Docket TSLI.P-001
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Simon
Serial No: 09/857,136
Filing Date: September 10, 2001
Title: Improved Signaling System for Telecommunications

REQUEST FOR REFUND

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Attached hereto is a copy of Monthly Statement of Deposit Account indicating a charge of \$295.00 for IPEA/US on October 15, 2001. A preliminary amendment was filed with this application canceling claims 9 - 15, a copy of which is enclosed. This preliminary amendment brings the claims into the position of satisfying the provisions of PCT Article 33(1)-(4). Thus the extra charge is not required.

Please issue a credit of \$295.00 due our firm and deposit it to our Deposit Account 15-0610.

Cert. under 37 CFR 1.8
This paper and the attachments named
herein are being deposited with the
United States Postal Service with
sufficient postage as first class mail
and addressed to Assistant Commissioner
for Patents, Washington, D.C. 20231 on

April 11, 2002

S. Howard S. Howard
Name Sign

Respectfully submitted,

OPPEDAHL & LARSON LLP

Carl Oppedahl
Carl Oppedahl
Reg. No. 32,746
P.O. Box 5068
Dillon, CO 80435-5068
970-468-6600

Enclosures



www.uspto.gov

March 17, 2003

OPPEDAHL AND LARSON LLP
P O BOX 5068
DILLON, CO 80435-5068
US

Dear Sir/Madam,

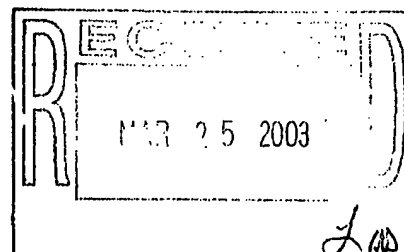
This is to Deny your refund request in the amount of \$295.00, for patent/serial number 09857136.

The IPER does not indicate that the claims meet the criteria for the smaller fee.

Sincerely,

A handwritten signature in cursive script that reads "Rita White".

RITA WHITE
PCT - National
Refund Section, Office of Finance



OPPEDAHL & LARSON LLP
DILLON, COLORADOCARL OPPEDAHL
MARINA T. LARSON, PH.D.TEL: + 1 970 468-6600
FAX: + 1 970 468-0104
WWW.PATENTS.COMRita White
PCT - National
US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Appl. no. 09/857,136

August 21, 2003

Dear Ms. White:

We are in receipt of your letter dated March 17, 2003 responding to our refund request dated April 11, 2002. The letter says:

The IPER does not indicate that the claims meet the criteria for the smaller fee.

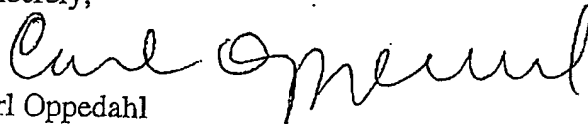
It is respectfully submitted that this statement is in error.

Attached for your convenient reference is a copy of the IPER. As may be seen, claims 1-8 meet the criteria for the smaller fee.

With our letter of April 11, 2002 we provided a copy of the preliminary amendment which was filed at the time of the entry into the national stage. Attached for convenient reference is another copy of that amendment. As may be seen, all claims other than claims 1-8 were canceled.

It is requested that you reconsider the position taken in your March 17, 2003 letter.

Sincerely,

Carl Oppedahl
PTO Reg. No. 32,746

RAM Fee History
Query
Revenue Accounting and Management

Name/Number: 09857136

Total Records Found: 13

Start Date: Any Date

End Date: Any Date

Accounting Date	Sequence Num.	Tran Type	Fee Code	Fee Amount	Mailroom Date	Payment Method
06/06/2001	00000303	<u>1</u>	<u>963</u>	\$50.00	06/04/2001	CK
09/17/2001	00000075	<u>1</u>	<u>254</u>	\$65.00	09/10/2001	CK
09/17/2001	00000076	<u>1</u>	<u>215</u>	\$55.00	09/10/2001	CK
10/15/2001	00000783	<u>1</u>	<u>963</u>	-\$50.00	06/04/2001	OP
10/15/2001	00000785	<u>1</u>	<u>957</u>	\$50.00	06/01/2001	CK
10/15/2001	00000784	<u>1</u>	<u>957</u>	\$295.00	06/01/2001	DA 150610
09/04/2002	00000006	<u>1</u>	<u>215</u>	\$55.00	06/27/2002	CC
09/24/2002	00000039	<u>1</u>	<u>957</u>	-\$295.00	06/01/2001	DA 150610
09/24/2002	00000040	<u>1</u>	<u>957</u>	-\$50.00	06/01/2001	OP
09/24/2002	00000041	<u>4</u>	<u>704</u>	-\$50.00	04/25/2002	CK
08/27/2003	00000129	<u>1</u>	<u>2401</u>	\$160.00	08/25/2003	CC
09/03/2003	00000053	<u>3</u>	<u>1806</u>	\$180.00	09/03/2003	CC
10/08/2003	00000333	<u>1</u>	<u>2501</u>	\$665.00	10/02/2003	CC
